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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,086	06/12/2000	Richard Marc Libman	LIB 2005-01	6844
23694 7590 03/14/2007 J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/592,086	Applicant(s) LIBMAN, RICHARD MARC	
	Examiner Raquel Alvarez	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-211 is/are pending in the application.
- 4a) Of the above claim(s) 160-163, 167, 177, 178, 181, 183, 188, 191-193, 196, 198, 199, 203, 207, 208 and 211 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189, 190, 194, 195, 200-202, 206, 209 and 210 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 1/11/2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189-190, 194-195, 197, 200-202, 206, 209-210 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al. (5,822,735 hereinafter De Lapa).

With respect to claims 1, 53-58, 64, 116-121, 127-131, 143-148, 150-151, 153, 154-159, 164-169, 179, 182, 185-187, 189-190, 194-195, 197, 200-202, 204, 209-210 De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1)Automatically determining whether to offer a product to said entity (figure 6);

(2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6);

(3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable

information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the content of said offering in said communication includes variable information such that said offering comprises said variable information in said offering at least partially identifies the product being offered to said entity (see Figure 2).

De Lapa teaches that said variable information may vary among persons being offered said product or said service such that offers of said product to said persons may vary from person to person (i.e. **assigning different coupon values** to non-customer versus regular customers in order to further induce the customer to the retail store)(in De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12).

DeLapa teaches the steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

With respect to the newly added feature of the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity ser who is being considered for an offer (i.e. the coupon can be assigned to more than one prior members who is eligible to receive the coupon)(col. 14, lines 33-40)

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for

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the banks to provide additional services or products that might be needed by the customers.

With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67)

Claims 12-52, 74-115, 132-138, 142, 170, 180 further recite selecting the format for the communication and said selected delivering medium. Official notice is taken that it is well known to select different mediums in which to deliver information to users. For example, some users prefer e-mail to regular mail and this is taken into account in order to select the medium in which to deliver information.

With respect to claims 59-63, 122-126, 139-140, 205-206 the claims further recite that the services relate to mortgage loan, insurance. Official notice is taken that mortgages loans and insurance related products are well known products or services offer to clients in order to meet client's needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the services or products to be related to mortgage loans and insurance in order to obtain the above mentioned advantages.

With respect to claim 141, De Lapa further teaches providing said communication and reply means to said entity electronically (Figure 5).

With respect to claim 149, 152 De Lapa further teaches selecting a first and second delivering medium that will be used to deliver subsequent communication pertaining to said offer (Figures 1 and 5).

Response to Arguments

3. Applicant argues that the Examiner has ignored some of the limitations in the dependent claims. The Examiner wants to point out that Applicant has presented an unreasonable number of dependent claims which are repetitious and multiplied, the Examiner has done her best to address all the claims presented. See explanation, below.

4. With respect to Applicant traversal with respect to the restriction requirement, the Examiner wants to point out that, if applicant files an amendment adding claims to a process invention, and the amendment includes process claims which do not depend from or otherwise require all the limitations of an allowable product, all claims directed to that newly added invention may be withdrawn from consideration, via an election by original presentation (see MPEP §821.03).

5. Applicant argues that De Lapa doesn't teach that each entity can be considered for the financial product/service. The Examiner respectfully disagrees with Applicant because in De lapa, the same type of coupons and services can be offered to each of the customer (entity). Products are matched to the customers and customers

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are matched to products in order to determine if the products can be offered to the customers. Each customer can be offered the same product. For example, a dog coupons will be offered to all dog owners (col. 5, lines 11-17).

6. Applicant argues that De Lapa doesn't teach customizing the promotion. The Examiner disagrees with Applicant because the coupon values are customized (col. 5, lines 11-17).

7. Applicant argues that the Examiner hasn't demonstrated how to modify DeLapa in order to incorporate financial products/services. The Examiner has taken Official Notice that replacing a consumable good with a financial product or service doesn't make the claims allowable if the process or end result is the same as the one being claimed.

8. Applicant argues that De Lapa doesn't teach a plurality of delivery mediums. The Examiner had taken official notice of such and since Applicant didn't command a response or request of such personal knowledge such as to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned.

9. With respect to dependent claims 53-58, Applicant doesn't specifically point out how the claims distinguish over De Lapa. Therefore the rejection is sustained.

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10. With respect to dependent claims 59-63, 122-126, 139-140 and 205-206, Applicant argues that De Lapa doesn't teach the specific features related to mortgage loans and insurance. The Examiner wants to point out that the specific features related to mortgages and insurances such as pricing said mortgages or insurances are characteristics of the financial products or services that are old and well known and that haven't been invented by Applicant.

11. The Examiner wants to point out that a non-elected claim is presumed to be withdrawn. See 37 CFR 1.121. A new listing of the claims must be supplied including their respective identifier. Correction is required.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

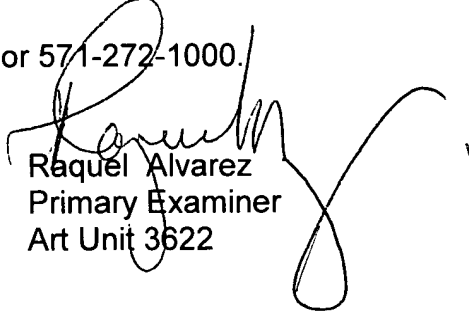
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
3/8/2007